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10/566,385	01/30/2006	Tetsuya Bono	126308	5512

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EXAMINER

WOOD, JARED M

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1793

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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Attachment to the Advisory Action

Applicant has argued that JP 2002-352837 (Saito) fails to disclose applicant's claimed control section. In support of this argument applicant alleges that the examiner has misapplied *In re Schreiber*, 128 F.3d 1473 (Fed. Cir. 1997) in support of the examiner's conclusion that functional limitations in product claims limit the structure of the product only inasmuch as the product is capable of performing the claimed function. Applicant further seeks to characterize *Schreiber* as only applying to the intended use of a product. However, functional limitations in product (or in this case apparatus) claims at their very essence are a limitation of an intended use and are not sufficient to distinguish an invention from the prior art excepting where the functional limitation would require or imply a structural feature not disclosed by the prior art. As cited by the examiner, Saito discloses all of the structural features present in applicant's claims. In particular, Saito's control section receives data from pressure, temperature, and voltage sensors and controls the opening and closing of various valves as well as controls the gas pressures in the line to which the valves are associated based upon sensory input (§ 0050-0141).

Applicant cites on page 3 of his remarks that claim 1 recites a "control section that controls..." and identifies this as a recitation of structure of applicant's claimed control section. It is unclear how applicant has determined that Saito's control section is incapable of controlling Saito's system since Saito discloses that the components of his fuel cell system (particularly the gas control valves) are controlled by the control section (§ 0050-0141).

Applicant argues on page 3, that the manner of control and how it is carried out distinguishes applicant's claim 1 from the prior art. However, as previously discussed, claims

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drawn to a product (or apparatus) must be distinguished from the prior art in terms of structure not function and therefore need only be capable of performing the claimed function. Applicant has provided no further evidence of any particular structure required by applicant's recitation of the desired function of the fuel cell system at large or, more specifically, the control section which is sufficient to distinguish applicant's system from that of the prior art.

Applicant further submits that "Saito discloses a completely different controller than that recited in claim 1". However, it is unclear how applicant has arrived at this determination since no structural characteristics of applicant's controller are claimed or disclosed except for the components which are controlled by the control section, the inputs into the control section, and the intended method of controlling performed by the control section. Saito's control section is disclosed in a similar manner in that no particular structure of the control section is disclosed other than the components which are controlled by the control section, the inputs into the control section, and the intended method of controlling performed by the control section. Saito's controller has at least substantially similar inputs and controls at least substantially similar components of Saito's fuel cell system. Given this, there is no evidence to support applicant's argument.

Although Saito's intended manner of control is different than that disclosed and claimed by applicant, since Saito's fuel cell system is, structurally, at least substantially similar to that disclosed by applicant, then Saito's fuel cell system would be capable of performing applicant's desired manner of control of the system.

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/JARED WOOD/

Examiner, Art Unit 1793

/J.A. LORENZO/

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